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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,874	04/14/2006	John Darcy Bradley	4505-1047	6839
<small>465</small> YOUNG & THOMPSON 209 Madison Street Suite 500 ALEXANDRIA, VA 22314			<small>7590</small> EXAMINER CHAN, SING P	
			ART UNIT 1791	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/575,874

**Applicant(s)**

BRADLEY ET AL.

**Examiner**

SING P. CHAN

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 September 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24, 27, 30-35, 37 and 42-47 is/are pending in the application.  
4a) Of the above claim(s) 33-35, 37, 42, 43 and 45-47 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 24, 27, 30-32 and 44 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 14 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☒ Notice of Draftsperson's Final Drawing Review (PTO-849)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/14/06  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of group I, claims 24, 27, 30-32 and 44 in the reply filed on September 10, 2008 is acknowledged. The traversal is on the ground(s) that the non-elected claims are "product-by-process" claims drawn to a label and the claimed label cannot be produced by a method other than that of the elected claims. This is not found persuasive because the instant case is filed under 35 USC 371, which fall under PCT rule for restriction. The lack of unity of invention is required for the restriction and as cited in restriction requirement, the special technical feature of marking the adhesive layer of a transparent label by ink jet is known as shown by Adams et al (U.S. 2003/0035014 A1). Therefore the special technical feature does not further contribute to the prior art as a whole and the lacks of unity of invention to a single general inventive concept is maintained. Further, the examiner noted, the newly added claims also added claims relating to a method of labeling a package using the indelibly marking label, which are withdrawn with as well as claims related to the label.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 33-35, 37, 42, 43, and 45-47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on September 10, 2008.

**35 USC 112, Sixth Paragraph**

3. Claim 31 recites "means-plus-function" requirement and the claim will be interpreted under 35 USC 112, Sixth Paragraph.

***Claim Objections***

4. Claim 27 is objected to because of the following informalities: In claim 27, line 2, "a laser marking process" should be "said laser marking process" or "the laser marking process." Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 24, 30, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al (U.S. 2003/0035014) in view of Sawada (U.S. 5,531,819), Louvel (GB 2,152,436), and He et al (U.S. 7,186,945).

Regarding claims 24 and 30, Adams et al discloses a method of reverse printing a label. The method includes providing a transparent face material (10), an adhesive

layer (12), (Paragraph 10) and using an ink jet, applying indicia (14) through a reverse printing protocol to the adhesive layer (12) (Paragraph 11). Adams et al is silent as to the ink jet's ink is a hot wax type ink. However, providing hot wax ink for ink jet printer is well known and conventional as shown for example by Sawada. Sawada discloses a hot melt ink for ink jet. The hot melt ink includes a wax, a dye as a colorant (Col 3, lines 24-36) and a plasticizer (Col 4, lines 44-56).

It would have been obvious to one of ordinary skill in the art at the time invention was made to provide hot melt ink with wax for ink jet printer as disclosed by Sawada in the method of Adams et al to provide an ink with a reduction of heat of fusion, improvement of transparency, prevention of release due to flexing of the printed matter, improve luster, and dissolution of dyes. (See Sawada, Col 1 line 64 to Col 2, line 2)

In the alternative, Adams et al is silent as to using a laser marker in place of the ink jet. However, interchanging the ink jet and a laser marker is well known and conventional as shown for example by Louvel. Louvel discloses a method of marking workpiece. The method includes providing a non-impact marking device (30) of either laser or ink-jet (Page 1, lines 91-96), and mounting the marking device (30) for movement across the article to be mark (Page 2, lines 30-43).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide either a laser or an ink jet to mark a substrate as disclosed by Louvel in the method of Adams et al to provide means of marking the adhesive of the label, which are interchangeable. Adams et al as modified by Louvel is silent as to the adhesive includes pigment or additive to effect or enhance the marking

in the adhesive layer. However, providing pigment in the adhesive layer, which can be marked by a laser is well known and conventional as shown for example by He et al. He et al discloses a method of marking wafers and dies. The method includes providing a sprayable adhesive with filler of either light or dark colored pigments or dyes (Col 1, lines 30-55). One of ordinary skill in the art reading Adams et al, Louvel, and He et al would appreciate the teaching of Adams et al to reverse marking the adhesive using ink jet printing and modifying Adams et al by the teaching of Louvel to use a laser to mark the adhesive and the teaching of He et al to add filler to the adhesive of Adams et al to allow for laser marking of the adhesive.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide pigments as filler for adhesive as disclosed by He et al in the method of Adams et al as modified by Louvel to provide a better color contrast to the mark improve legibility. (See He et al, Col 8, lines 35-37)

Regarding claim 31, Adams et al discloses the label is feed via dispensing module (22) past the print heads of the printer (26) (Paragraph 13), which provide relative movement between the label and means for applying the marking.

Regarding claim 32, Adams et al discloses the indicia (14) include text and graphic. (Paragraph 11)

8. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al (U.S. 2003/0035014) in view of Sawada (U.S. 5,531,819), Louvel (GB 2,152,436), and He et al (U.S. 7,186,945) as applied to claim 24 above, and further in view of Delp et al (U.S. 6,924,077).

Adams et al as modified above is silent as to using a green light laser or CO<sub>2</sub> laser to mark the adhesive. However, using CO<sub>2</sub> or Dd:YAG laser or excimer laser to mark material with pigments is well known and conventional as shown for example by Delp et al. Delp et al discloses providing a plastic or coating with one or more pigments (Col 1, lines 46-56) and providing laser such as CO<sub>2</sub> or Dd:YAG laser or excimer laser to inscribe the plastic or coating and the laser wavelength ranged from 1060 nm to 157 nm (Col 4, lines 17-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide laser such as CO<sub>2</sub> or Dd:YAG laser or excimer laser with wavelength ranged from 1060 nm to 157 nm, which included green laser as disclosed by Delp et al in the method of Adams et al as modified by combination of references to provide a high speed graphic inscriptions with resistant to abrasion. (See Delp et al, Col 1, lines 21-24)

9. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al (U.S. 2003/0035014) in view of Sawada (U.S. 5,531,819), Louvel (GB 2,152,436), and He et al (U.S. 7,186,945) as applied to claim 24 above, and further in view of Sato (U.S. 4,061,808).

Adams et al as modified above is silent as to the label includes one or more weakened portion or areas. However, providing perforations or weakened portion on labels is well known and conventional as shown for example by Sato. Sato discloses forming labels on a carrier backing strip. The labels include feeding perforations (29)

arranged in a row transverse to the direction of extension of the label strip (Col 5, lines 24-30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide perforations or weakened portions or areas on labels as disclosed by Sato in the method of Adams et al as modified by combination of references to allow even distribution of feeding forces without an undesired concentration of forces to allow for smooth feeding and peeling off. (See Sato, Col 5, lines 31-39)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SING P. CHAN whose telephone number is (571)272-1225. The examiner can normally be reached on Monday-Thursday 7:30AM-11:00AM and 12:00PM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sing P Chan/  
Acting Examiner of Art Unit 1791